



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/825,352 | 04/15/2004 | Roy Schoenberg | 66729/P028US/10613659 | 8650 |
| 29053 7590 05/15/2009 FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784 | | | | |
| EXAMINER KOPPIKAR, VIVEK D | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3686 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 05/15/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,352

Applicant(s)

SCHOENBERG, ROY

Examiner

VIVEK D. KOPPIKAR

Art Unit

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. Claims 1-40 have been examined in this application. This communication is a Final Office Action in response to the "Amendment" and "Remarks" April 23, 2009 in an attempt to overcome the Schoenberg reference used in the Office Action mailed March 17, 2009.

Subsequent to the mailing of the Advisory Office Action on April 30, 2009, the Office reconsidered its position and is withdrawing the Final Office Action mailed on March 17, 2009 and is now issuing this instant Final Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 7 of claim 35, it is not clear what the word "respective" is intended to mean. It is not clear whether "respective" refers to different (as in greater or lesser) levels of security or whether "respective" simply refers to separate confidentiality levels (as in different access keys for different sets of medical records). Appropriate correction and/or clarification is required. For the purposes of examination, the Office will interpret the term "respective" to mean either varying levels of security or as meaning separate access keys.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 11-14, 17, 28-31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 7,304,852 to Kerr, II et al. in view of US Patent Number 6,041,347 to Harsham in further view of US Patent Application Number 2004/0205540 to Vulpe.

(A) As per claim 1, Kerr teaches a rule processing computer-based method (Kerr: Abstract) comprising:

defining a target group of patients chosen from a group of existing patients (Kerr: Col. 9, Ln. 1-30);

defining an action to be taken concerning one or more patients within the target group of patients (Kerr: Col. 1, Ln. 1-30); and

scheduling an execution time for the action (Kerr: Col. 9, Ln. 1-30);

initiating by the computer, in accordance with the scheduled execution time, the action concerning corresponding patients to which the determined one or more medical records that satisfy the rule relate (Kerr: Col. 9, Ln. 1-30).

Kerr does not teach the following features which are taught by Harsham:

receiving user input to a processor-based computer for defining a computer-executable rule (Harsham: Col. 5, Ln. 61-Col. 6, Ln. 29). At the time of the invention, it would have

been obvious for one of ordinary skill in the art to have modified Kerr with the aforementioned teachings from Harsham with the motivation of having a means of configuring a computer network in an object-oriented manner, as recited in Harsham (Col. 5, Ln. –Col. 6, Ln. 19).

The combined teachings of Kerr in view of Harsham do not teach the following feature which is taught by Vulpe (Sections [0069] and [0080]):

processing, by the computer, a plurality of computer-based records against said computer-executable rule to determine one or more of said medical records that satisfy the rule, wherein each of the medical records contain at least a portion of a corresponding patient's medical history stored to computer-readable medium (Note: Vulpe recites that its system is used for records but does not state that the records are medical records, however, the Office takes the position that the term "records" in Vulpe includes medical records).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Kerr in view of Harsham with the aforementioned teachings from Vulpe with the motivation of having a means of determining which records satisfy a particular rule, as recited in Vulpe (Vulpe: Section [0069]).

- (B) As per claim 2, in Kerr the processing includes processing the medical records of the existing patients to determine which of the medical records define the existence of a selected condition (Kerr; Col. 9, Ln. 1-30).
- (C) As per claim 3, Kerr teaches that the selected condition concerns a medical condition of a patient (Kerr; Col. 9, Ln. 1-30).

(D) As per claim 4, Kerr teaches that the selected condition concerns a physical criteria of a patient (Kerr: Col. 9, Ln. 1-30).

(E) As per claims 5-6, Kerr teaches that the selected condition teaches a habit of a patient or activity of a patient (Kerr: col. 1, Ln. 12-31).

(F) As per claim 7, in Kerr the action includes one or more of:

posting a HTML link for a patient;

posting a message for a patient;

providing a tool to a patient;

transmitting an email to a patient;

updating a patient's medical record;

transmitting a pop-up message to a patient;

recommending that a patient join a discussion board;

providing a patient with medical information;

providing a medical report to a patient;

providing a medical report to a third party;

executing a program; and

notifying a third party (Kerr: Col. 2, Ln. 58-Col. 3, Ln. 3 and Col. 9, Ln. 1-30).

(G) As per claim 8, Kerr teaches that the step of scheduling an execution time includes specifying a single, non-recurring, execution time (Kerr: Col. 2, Ln. 58-Col. 3, Ln. 3).

(H) As per claim 11, Kerr the step of initiating the action in accordance with the scheduled execution time comprising initiating on or after the execution time the action

concerning the corresponding patients to which the determined one or more medical records that satisfy that rule relate (Kerr: Col. 2, Ln. 58-Col. 3, Ln. 3 and Col. 9, Ln. 1-30).

(L) As per claims 29-31 and 34, these claims are substantially similar to Claims 1-8 and 11, above, and are therefore rejected on the same basis, which is set forth above.

6. Claims 9-10, 15-16 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerr, as applied to Claim 1, and in further view of US Patent Number 7,447,663 to Barker.

(A) As per claims 9-10, Kerr does not teach that the step of scheduling an execution time includes specifying a plurality of non-recurring execution times nor does Kerr teach that the step of scheduling an execution time includes specifying a recurring execution time, however, this feature is taught in Barker (Col. 5, Ln. 17-36). At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the teachings of Kerr with these aforementioned teachings from Barker with the motivation of having means of allowing a user or a client to specify the criteria or conditions (e.g. frequency of occurrences) that a certain rule would be executed, as recited in Barker (Col. 5, Ln. 17-36).

(B) As per claims 15-16 and 32-33, these claims are substantially similar to Claims 9 and 10 and are therefore rejected on the same basis, as is set forth above.

7. Claims 12-28 and 35-40 are rejected under 35 U.S.C.103 (a) as being unpatentable over Kerr in view of US Patent Application Publication 2002/0077856 to

Art Unit: 3686

Pawlikowski and in further view of Vulpe and in even further view of US Patent Number 6,398,727 to Bui.

(A) As per claim 12, the combined teachings of Kerr in view of Pawlikowski teach a rule processing computer-based method comprising:

determining by a computer, for a specific computer-executable rule that is stored to a computer-readable medium, a target group of patients (Kerr: Col. 9, Ln. 1-30);

determining for a specific rule, an action to be taken concerning one or more patients within the target group of patients (Kerr: Col. 9, Ln. 1-30);

determining for said specific computer-executable rule, an execution time for the action (Kerr: Col. 9, Ln. 1-30); and

initiating by the computer the action concerning the one or more patients within the target group of patients on or after the execution time (Kerr: Col. 9, Ln. 1-30).

Kerr does not each the following feature which is taught by Pawlikowski (Section [0100])

wherein said target group of patients comprise at least a subset of patients for whom a particular medical service provider has an access key that grants the medical service provider access to medical records of the patients

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Kerr with these aforementioned teachings from Pawlikowski with the motivation of having a means of providing security to the medical device and medical or patient records.

The combined teachings of Kerr in view of Pawlikowski do not teach a computer-executable rule which is initiated by a computer whose respective medical records satisfy the specific computer-executable rule, however, this feature is taught by Vulpe (Sections [0069] and [0080]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Kerr in view of Pawlikowski with the aforementioned teachings from Vulpe with the motivation of having a means of determining which records satisfy a particular rule, as recited in Vulpe (Vulpe: Section [0069]).

Kerr does not teach the step of communicating information to one or more patients, however this feature is well known in the art as is illustrated by Bui (Col. 17, Ln. 29-40). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Kerr with these aforementioned teachings from Bui with the motivation of having a means of communicating information to a patient as recited in Bui (Col. 17, Ln. 29-40).

(B) As per claims 13-17, these claims are substantially similar to claims 7-11 and are therefore rejected on the same basis as these claims which is set forth above.

(C) As per claims 18-19, these claims are substantially similar to claims 12 and 1, above, respectively and are therefore rejected on the same basis as these claim, which is set forth above.

(D) As per claims 20-23, these claims are substantially similar to claims 3-6 and are therefore rejected on the same basis as these claims, which is set forth above.

(E) As per claims 24-28, these claims are substantially similar to claims 7-11 and are therefore rejected on the same basis as these claims, which is set forth above.

(F) As per claims 35-40, these claims are substantially similar to claims 1-11 and 12-27 and are therefore rejected on the same basis as these claims, which is set forth above.

Response to Arguments

8. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Jerry O'Connor, can be reached at (571) 272-6787. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

/Vivek D Koppikar/

Primary Examiner, Art Unit 3686